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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/027,002	12/20/2001	Frederick Murray Burg	2001-0208	9435

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EXAMINER

AILES, BENJAMIN A

ART UNIT	PAPER NUMBER
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2142

DATE MAILED: 08/12/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/027,002	BURG, FREDERICK MURRAY	
	Examiner	Art Unit	
	Benjamin A. Ailes	2142	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 June 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5,8-10 and 15-17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5,8-10 and 15-17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

1. This action is in response the Amendment filed 06 June 2005.
2. Claims 1-5, 8-10, and 15-17 remain pending.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-5, 8-10, and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Okumura et al. (U.S. 5,293,250), hereinafter referred to as Okumura, in view of Naylor et al. (U.S. 6,625,642), hereinafter referred to as Naylor.

5. Regarding claim 1, Okumura discloses a method comprising the steps of:

receiving in a communications network the message from the sender (col. 2, lines 24-31);

determining whether the sender requested that the message recipient receive independent notification of the message (col. 2, lines 31-39).

Okumura discloses the independent notification method, as disclosed above, utilizing the method of receiving an identifier and sending notifications to the recipient (see col. 2, lines 31-39), however does not explicitly disclose extracting (retrieving) the identifier explicitly from the message. Naylor discloses a method for sending electronic mail messages that include both the intended recipient's e-mail address and telephone number. A user (sender) is able to set priority to the messages being sent and have

notifications of the message to be sent to an e-mail inbox and also to other locations, including facsimile machines or telephones, both of which would require the use of a telephone number used for identification purposes (see Naylor, col. 2, lines 59-66).

One of ordinary skill in the art at the time of the applicant's invention would have recognized that when sending an e-mail message with high priority, and a need for an alert or notification is to be sent to the user, more than just regular identification is needed (this being the email address) and that more identification is needed to be sent along by the sender, in this case the telephone number. It is for these reasons that one of ordinary skill in the art would have found it advantageous and apropos to utilize a method as disclosed by Naylor in combination with Okumura.

6. Regarding claim 2, Okumura discloses the method wherein the independent notification includes a telephone call to the recipient (col. 6, lines 29-47).

7. Regarding claim 3, Okumura discloses the method wherein the telephone call is routed to one of a telephone set, a pager and facsimile machine associated with the message recipient (col. 6, lines 29-47 and Figure 11).

8. Regarding claim 4, Okumura discloses the method wherein the message launched by the sender comprises an e-mail message (col. 2, lines 24-31).

9. Regarding claim 5, Okumura discloses the method wherein the network determines whether the sender requested independent notification by examining a recipient notification header in the e-mail message that will have a predetermined designation when the sender has requested independent notification (col. 4, lines 48-65, specifically lines 48-55).

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10. Regarding claim 8, Okumura discloses a method comprising the steps of:

receiving in a communications network the message from the sender (col. 2, lines 24-31);

determining whether the sender requested that the message recipient receive voice notification of the message (col. 2, lines 31-39);

Okumura discloses the independent notification method, as disclosed above, utilizing the method of receiving an identifier and sending notifications to the recipient (see col. 2, lines 31-39), however does not explicitly disclose extracting (retrieving) the identifier explicitly from the message. Naylor discloses a method for sending electronic mail messages that include both the intended recipient's e-mail address and telephone number. A user (sender) is able to set priority to the messages being sent and have notifications of the message to be sent to an e-mail inbox and also to other locations, including facsimile machines or telephones, both of which would require the use of a telephone number used for identification purposes (see Naylor, col. 2, lines 59-66). One of ordinary skill in the art at the time of the applicant's invention would have recognized that when sending an e-mail message with high priority, and a need for an alert or notification is to be sent to the user, more than just regular identification is needed (this being the email address) and that more identification is needed to be sent along by the sender, in this case the telephone number. It is for these reasons that one of ordinary skill in the art would have found it advantageous and apropos to utilize a method as disclosed by Naylor in combination with Okumura.

11. Regarding claim 9, Okumura discloses the method wherein the message launched by the sender comprises an e-mail message (col. 2, lines 24-31).

12. Regarding claim 10, Okumura discloses the method wherein the network determines whether the sender requested voice notification by examining a recipient notification header in the e-mail message that will have a predetermined designation when the sender has requested voice notification (col. 4, lines 48-65, specifically lines 48-55).

13. Regarding claim 15, Okumura discloses the independent notification method, as disclosed above, utilizing the method of receiving an identifier and sending notifications to the recipient (see col. 2, lines 31-39), however does not explicitly disclose extracting (retrieving) the identifier explicitly from the message. Naylor discloses a method for sending electronic mail messages that include both the intended recipient's e-mail address and telephone number. A user (sender) is able to set priority to the messages being sent and have notifications of the message to be sent to an e-mail inbox and also to other locations, including facsimile machines or telephones, both of which would require the use of a telephone number used for identification purposes (see Naylor, col. 2, lines 59-66). One of ordinary skill in the art at the time of the applicant's invention would have recognized that when sending an e-mail message with high priority, and a need for an alert or notification is to be sent to the user, more than just regular identification is needed (this being the email address) and that more identification is needed to be sent along by the sender, in this case the telephone number. It is for

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these reasons that one of ordinary skill in the art would have found it advantageous and apropos to utilize a method as disclosed by Naylor in combination with Okumura.

14. Claims 16 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Okumura and Naylor in view of Cao et al. (U.S. 6,745,230), hereinafter referred to as Cao.

15. Regarding claim 16, Okumura and Naylor disclose the use of a telephone number as an identifier as explained above, however does not explicitly disclose the identifier comprising a multiple amount of phone numbers (a plurality of phone numbers). However, in related art, Cao discloses the ability for alerts/notifications to be sent to a plurality of phone numbers, made possible by the use of an identifier encompassing a multiple amount of locations where notifications are to be sent, in this case a multitude of phone numbers (col. 3, lines 40-46). One of ordinary skill in the art at the time of the applicant's invention would have found it obvious to combine the method disclosed by Cao with Okumura and Naylor in order to enable alerts/notifications to be sent to multiple locations. It is for this reason that one of ordinary skill in the art would be motivated to utilize the method of multiple location alerting/notifyng as disclosed by Cao.

16. Claim 17 contains similar subject matter and is rejected under the same rationale as claim 16.

Response to Arguments

17. Applicant's arguments with respect to all claims have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

18. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

19. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Watanabe et al. (U.S. 6,850,757) disclose a mail notification apparatus and a mail notification method.

Kumar et al. (U.S. 6,240,445) disclose a computer implemented method and apparatus for receiving facsimile messages using an identifier appended to a shared telephone number.

Meier et al. (U.S. 2001/0027478 A1) discloses a messaging system using a directory service.

Takatsuki (U.S. 2003/0096599 A1) discloses a message distribution system and method for selecting the device where a recipient is most likely to recognize a message.

Wang (U.S. 5,956,521) discloses a system for universal electronic mail delivery where messaging devices are notified using a particular dialing, ringing, and hanging-up pattern.

Smith et al. (U.S. 5,790,790) disclose electronic document delivery system in which notification of said electronic document is sent to a recipient thereof.

Vazana (U.S. 5,850,519) discloses computerized mail notification system and method which detects calls from a mail server.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Benjamin A. Ailes whose telephone number is (571)272-3899. The examiner can normally be reached on M-F 7:30-5, First Friday Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Caldwell can be reached on (571)272-3868. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

baa

Beatriz Prieto
BEATRIZ PRIETO
PRIMARY EXAMINER